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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,293	12/21/2001	Shuji Sasaki	9683/98	4503

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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/037,293

Applicant(s)

SASAKI ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Feb 25, 05</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1-7 are canceled.
- Claims 8-25 are added
- Claims 8-25 are considered.

### ***Response to Amendment***

2. Applicant's arguments filed 10 February 2005 with respect to new claims 8-25 have been fully considered but they are not persuasive as well as they are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,602,933 to Richard A. Blackwell et al.

3. As per claims 24 and 25, Blackwell clearly teaches a proxy computer that serves a plurality of financial institutions and directs settlement information received via a communication network from a settlement terminal to a designated financial institution, comprising:

a database that stores IDs of settlement terminals which are allowed to access the proxy computer (See Blackwell column 10, lines 29-40 and column 12, lines 43-48);

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a receiver that receives from a settlement terminal a verification request that comprises an ID of the settlement terminal, wherein the receiver receives the verification request only when the communication network successfully verifies a communication unit of the settlement terminal (See Blackwell column 10, lines 4-48 and column 11, line 26-column 12, lines 48);

a terminal identifier that verifies the settlement terminal by confirming the ID of the settlement terminal against the IDs stored in the database (See Blackwell column 10, lines 29-40 and column 12, lines 25-51); and

a transmitter that, only when the settlement terminal is successfully verified, directs the settlement information from the settlement terminal to the designated financial institution (See Blackwell column 10, lines 29-40 and column 12, lines 25-51).

the proxy computer is connected to the communication network via a dedicated line (See Blackwell column 5, lines 34-64).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,280,625 to David R. Howarter et al. in view of U.S. Patent No. 5,602,933 to Richard A. Blackwell et al.

6. As per claims 8 and 17, Howarter clearly discloses a settlement processing method comprising:

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- transmitting information relating to a sales transaction by a transmitter (See Howarter figure 1, column 3, lines 54-59, column 4, lines 1-13);
- receiving the information from the transmitter by a satellite (See Howarter figure 4, column 7, lines 54-64 and column 8, lines 3-10);
- transmitting the received information (where the information corresponds to card information read by a card reader) by the satellite (See Howarter figure 4, column 7, lines 41-68 and column 8, lines 1-10);
- receiving the information from the satellite by a communications network (See Howarter figures 1, 4 and 8, column 7, lines 54-64 and column 8, lines 3-10);
- receiving the information from the satellite through the communications network by a settlement unit (Where settlement unit corresponds to host computer) (See Howarter figures 1, 4 and 8, column 7, lines 54-64, column 8, lines 3-10 and column 10, lines 58-65); and
- processing a settlement of sales transaction (where settlement of sales transaction corresponds to returned verification information) based on the received information by the settlement unit (See Howarter column 11, lines 37-42).

What Howarter is not explicitly clear about is, the delay time for establishing communication between the terminal and the central server and the step of while communication path is being established, during which time the collection of settlement information is progressing.

However, Blackwell clearly discloses that during the "connection to banker" the terminal collects data, packetizes the data and prepares the data for transmission.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to collect all the information related to the settlement while the system is trying to make the secure connection for the motivation of the speeding up the process of transaction by multitasking as it would be verification of connection as well as collection of information.

7. As per claims 9 and 18, Howarter clearly discloses all the limitations of claims 8 and 17, further;

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Howarter discloses the communication path with the proxy computer comprises a satellite communication path (See Howarter figure 4, column 7, lines 54-64 and column 8, lines 3-10).

8. As per claims 10-12 and 19-21, Howarter clearly discloses all the limitations of claims 8 and 17, further;

Howarter is not specific on connection protocols. However, Blackwell is clear on the specifics of the connection establishment,

a timing when the user interface control activates the communication connection control to initiate establishing the communication path with the proxy computer is determined based on at least one of an amount of expected time delay to be incurred in establishing the communication path and an amount of settlement information to collect See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

while establishing the communication path with the proxy computer, the communication connection control first establishes a connection with the mobile communication network See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

the communication connection control initiates establishing a connection with the mobile communication network by sending a connection request to the wireless communication unit, which then sends a packet communication registration request to the mobile communication network (See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

the communication connection control, when receiving from the wireless communication unit a notification of establishment of a connection to the mobile communication network, sends a verification request to the proxy computer in order for the proxy computer to verify the settlement terminal to determine if the settlement terminal can legitimately access the proxy computer See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Howarter and Blackwell for the motivation of achieving the speed, portability, and security of a mobile transaction system.

9. As per claims 13-16 and 22-23, Howarter clearly discloses all the limitations of claims 12 and 17, further; Howarter is not specific on connection protocols and verifications. However, Blackwell is clear on the specifics of the connection establishment and verification of the terminal,

establishing a connection with the mobile communication network comprises receiving a request for a wireless communication unit ID from the mobile communication network (See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

establishing a connection with the mobile communication network comprises sending the wireless communication unit ID to the mobile communication network in order for the network to verify the mobile unit to determine if the mobile unit can legitimately access the network (See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

establishing a connection with the mobile communication network comprises, if the wireless communication unit is successfully verified by the mobile communication network, notifying the settlement terminal of establishment of a connection to the network (See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

establishing a communication path between the settlement terminal and the proxy computer comprises relaying a verification request from the settlement terminal to the proxy computer via the mobile communication network in order for the proxy computer to verify the settlement terminal to determine if the settlement terminal can legitimately access the proxy computer (See Blackwell column 10, lines 4-40 and column 11, line 26-column 12, lines 48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of the Howarter and Blackwell for the motivation of achieving a further security and trust between the collection terminal and the processing server.

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**Conclusion**

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

**<http://portal.uspto.gov/external/portal/pair>**

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

**(703) 305-7687** [Official communications; including After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

**Knox Building, 50 Dulany St. Alexandria, VA.**

**Kambiz Abdi**  
Examiner

**May 12, 2005**

**JAMES P. TRAMMELL**  
SUPERVISORY PATENT EXAMINER  
TECHNICAL SERVICES